



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,832	03/31/2004	Hermann Lueckhoff	13906-164001	6486
32864	7590	04/01/2009		
FISH & RICHARDSON, P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER SHAW, PELING ANDY	
			ART UNIT 2444	PAPER NUMBER
			NOTIFICATION DATE 04/01/2009	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

# Office Action Summary

**Application No.**

10/814,832

**Applicant(s)**

LUECKHOFF, HERMANN

**Examiner**

PELING A. SHAW

**Art Unit**

2444

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 23 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CD/CD)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Amendment received on 01/05/2009 has been entered into record. Specification changes are reviewed and accepted. Claims 1, 11 and 13-15 are amended. Claims 1-22 are currently pending.
2. Amendment received on 07/16/2008 was entered into record. The Office acknowledges the receipt of Applicant's restriction election. Applicant elects Group a, claims 1-10, 11-14 and 15-22, without traverse. Claims 23-24 were withdrawn.

***Priority***

3. This application has no priority claim made. The filing date is 03/31/2004.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11-14 and 15-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

- a. Claims 11 and 15 are amended with the limitation of “a computer program product tangibly embodied in a computer readable medium and containing/including executable instructions”. In addition applicant has amended line 15 on page 19 of applicant's specification. Applicant seems intend to use “computer readable medium” while avoid the term of “propagated signal” not conforming 35 U.S.C. 101. However, applicant's usage of computer readable medium is not clear to prohibit any other possible means not conforming 35 U.S.C. 101, e.g. an information carrier could be a transmission media if not a propagated signal. Thus it could still be interpreted to

means not conforming 35 U.S.C. 101. Thus claims 11, 15 and their dependent claims 12-14 and 16-22 are still rejected. For the purpose of applying art, the limitation is read “computer program stored in a machine-readable storage device” as per lines 15-29 on page 19 of applicant’s specification as in previous similar claim rejection under 35 U.S.C. 101 in office action mailed on 10/16/2008,

Appropriate corrections are required.

*Claim Rejections - 35 USC § 112, first paragraph*

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the original specification and claims in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

- a. Claims 1, 11 and 15 are amended with the limitation of “accessing fact attributes within the incoming electronic message and comparing the fact attributes with meta information stored in the computer system” that is not found in the original specification or claims. The fact attributes are part of meta information as per claim 5, 14 and 19 language or item 202 in Fig. 2 and related specification, particularly 2<sup>nd</sup>, 4<sup>th</sup> paragraphs on page 13 of applicant’s specification. They are used to retrieve fact information as per 5<sup>th</sup> paragraphs on page 17 of applicant’s specification. Thus is not

as currently amended claim 1, 11 and 15 language. Although the amended changes seem to be irrelevant to the application and to the applying of prior arts in the following rejection, these changes still modify the scope of the invention and introduce new subject matter into the application. It would require undue experimentation for one of ordinary skill in the networking art at the time the invention was made to be able to add and test all these functions inclusively rather than just pick a particular function for implementation. Claims 1, 11, 15, their depending claims 2-10, 12-14 and 16-20 are thus rejected. For the purpose of applying art, the limitations are read in light of the quoted paragraphs from applicant's specification above.

Appropriate corrections are required.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5-9, 11-17, 19-22 are rejected under 35 U.S.C. 102(e) as being anticipated by

Arora et al. (US 20040064512 A1), hereinafter referred as Arora.

- a. Regarding claim 1, Arora disclosed a method for use in a computer system for responding to received electronic messages, the method comprising: upon receipt of an incoming electronic message in a computer system (paragraph 18: join an instant message group), accessing fact attributes within the incoming electronic message and comparing the fact attributes with meta information stored in the computer system to determine a first pre-selected class of a plurality of classes of stored fact information (paragraph 80: join the network, query and index registered keywords and subjects of interest, registered metadata); retrieving a portion of the stored fact information that is a member of the first pre-selected class (paragraph 86: membership service); and storing the retrieved portion of the stored fact information in an electronic file that is associated with the incoming electronic message such that a rule for processing the

- incoming electronic message can be applied to the retrieved portion (paragraph 129: share a common set of interests and rules to publish, share and access contents)..
- b. Regarding claim 2, Arora disclosed the method of claim 1, wherein the portion of the stored fact information is retrieved when there is a need to apply the rule (paragraph 719: rule by which security is enforced).
- c. Regarding claim 3, Arora disclosed the method of claim 1, wherein the computer system includes a workflow for processing the incoming electronic message and wherein the method further comprises providing the electronic file with a lifetime bound to the workflow (paragraph 82: item of content may have associated expiration time; paragraphs 258, 351 and 682: services using “time to live”; paragraphs 512, 520, 523 and 596: rendezvous service, query propagation within the limits of loop and TTL).
- d. Regarding claim 5, Arora disclosed the method of claim 1, wherein the meta information includes the rule and a fact attribute identified by the rule, the fact attribute identifying the first pre-selected class of stored fact information, and wherein accessing the meta information comprises accessing the rule and the fact attribute (paragraph 129: share a common set of interests and that have agreed upon a common set of rules to publish, share and access any computer content (code, data, applications, or other collections of computer representable resources); paragraph 719: rule by which security is enforced).
- e. Regarding claim 6, Arora disclosed the method of claim 5, further comprising performing an initial screening of the incoming electronic message before accessing

- the meta information, wherein a result of the initial screening is used to select the rule from a plurality of rules (paragraph 129: share a common set of interests and that have agreed upon a common set of rules to publish, share and access any computer content (code, data, applications, or other collections of computer representable resources); paragraph 481: membership screening; paragraph 510: filtering and distributing requests for the best usage of network resources).
- f. Regarding claim 7, Arora disclosed the method of claim 5, wherein the meta information further includes an identifier specifying where the retrieved portion of stored fact information is to be stored in the electronic file, and wherein the identifier is used in storing the retrieved portion (paragraph 16: store a zone of instant messaging distributed index, instant messaging information for a subset of the peers at locations in the zone indicated by hashes of identifiers of the peers in the instant messaging group).
- g. Regarding claim 8, Arora disclosed the method of claim 7, further comprising using the identifier to access the retrieved portion of stored fact information in the electronic file to apply the rule to the retrieved portion (paragraph 129: share a common set of interests and rules to publish, share and access contents; paragraph 719: rule by which security is enforced).
- h. Regarding claim 9, Arora disclosed the method of claim 7, wherein the identifier is an XPath query (paragraph 11, XPath for locate and process items in XML; paragraph 64: XPath query for XML).



- i. Claims 11-14 are of the same scope as claims 1-3 and 5-6. These are rejected for the same reasons as for claims 1-3 and 5-6.
- j. Claims 15-17 and 19-22 are of the same scope as claims 1-3, 5 and 7-9. These are rejected for the same reasons as for claims 1-3, 5 and 7-9.

Arora disclosed all limitations of claims 1-3, 5-9, 11-17, 19-22. Claims 1-3, 5-9, 11-17, 19-22 are rejected under 35 U.S.C. 102(c).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 10 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arora as applied to claim 1 above, and further in view of Chandra et al. (US 7130885 B2), hereinafter referred as Chandra.

- a. Regarding claim 4, Arora disclosed the invention substantially as claimed. Arora does not explicitly disclose wherein the electronic file is an XML document and the retrieved portion is stored in the XML document using an XSL transaction. However, Arora does show (paragraph 662) using XML to send message of different types.
- b. Chandra shows (Fig. 18E and column 71, line 38-column 72, lines 8) that XSL style sheet is used to generate XML) in an analogous art for the purpose of providing electronic messages that are linked and aggregated.
- c. It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to modify Arora's functions of instant messaging using distributed indexes with Chandra's functions of using XSL to generate XML.
- d. The modification would have been obvious because one of ordinary skill in the art would have been motivated to further detail how XML would be implemented in the electronic messaging system as per Chandra in the general art of using XML in

messaging as per Arora (paragraph 347) and Chandra (column 67, lines 36-53)'s teaching.

- e. Regarding claim 10, Chandra shows wherein the retrieved portion of the stored fact information pertains to at least one category selected from the group consisting of: a business context of the incoming electronic message, analytical data relating to the incoming electronic message, availability of a person for attending to the incoming electronic message, a skill of a person for attending to the incoming electronic message, communication information relating to the incoming electronic message, an industry with which the incoming electronic message is associated, and combinations thereof (Fig. 13A and 13D; column 54, line 44-column 55, line 4: invitation to meet; column 55, lines 57-67: schedule for availability). Arora shows (paragraph 485) embodiments of a peer-to-peer platform discovery service may leverage surrounding peers and peer groups, provide meetings points for far away peers and groups, use an asynchronous protocol and provide reverse discovery; and (paragraph 508) a rendezvous peer may be described as a meeting point where peers and/or peer groups may register to be discovered, and may also discover other peers and/or peer groups, and retrieve information on discovered peers and/or peer groups.
- f. Claim 18 is of the same scope as claim 4. It is rejected for the same reasons as for claim 4.

Together Arora and Chandra disclosed all limitations of claims 4, 10 and 18. Claims 4, 10 and 18 are rejected under 35 U.S.C. 103(a).

***Response to Arguments***

8. Applicant's arguments filed on 01/05/2009 have been fully considered, but they are not persuasive.
- a. Applicant has argued (3<sup>rd</sup> paragraph on page 10 of current amendment) that Arora does not disclose a method that determines a response to a received electronic message by analyzing fact attributes stored within an electronic message; further, Arora does not anticipate a method which uses both fact attributes stored within the electronic message and meta information for purposes of determining appropriate processing rules and applying those rules to the incoming electronic message. This argument seems to base upon the amended claim change of "accessing fact attributes within the incoming electronic message and comparing the fact attributes with meta information stored in the computer system". Examiner has searched and did not find the support for the amended change and has rejected the amended claim changes as per item a of section 5 above.
  - b. Applicant has argued (3<sup>rd</sup> paragraph on page 11 of current amendment) that Arora does not disclose of suggest a "lifetime" of the electronic file that is bound to a particular workflow, i.e. the limitation of "providing the electronic file with a lifetime bound to the workflow" in claim 3. Examiner has searched and found that Arora has shown (paragraph 82) item of content may have associated expiration time; (paragraphs 258, 351 and 682) services using "time to live"; (paragraphs 512, 520, 523 and 596) rendezvous service, query propagation within the limits of loop and TTL. These should read on the argued limitation.

- c. Applicant has argued (1<sup>st</sup> paragraph on page 12 of current amendment) that the cited rules in Arora are not associated with pre-selected classes of stored fact information, nor are they stored and/or maintained as meta information along with electronic documents sent between users or between the system and a user, i.e. the limitation of “wherein the meta information includes the rule and a fact attribute identified by the rule, the fact attribute identifying the first pre-selected class of stored fact information, and wherein accessing the meta information comprises accessing the rule and the fact attribute” in claim 5. Examiner has searched and found Arora has shown (paragraph 129) sharing a common set of interests and that agreeing upon a common set of rules to publish, share and access any computer content (code, data, applications, or other collections of computer representable resources); and (paragraph 719) rule by which security is enforced.
- d. Applicant has argued (2<sup>nd</sup> paragraph on page 12 of current amendment) that Arora does not perform the initial screening of documents, nor does it perform an initial screening for purposes of selecting rules for handling particular electronic documents, i.e. the limitation of “further comprising performing an initial screening of the incoming electronic message before accessing the meta information, wherein a result of the initial screening is used to select the rule from a plurality of rules” in claim 6. Examiner has reviewed and found Fig. 3 and 5<sup>th</sup> paragraph on page 17 of applicant’s original specification has mentioned the term of “initial screening” without further detail. Examiner has searched and found Arora has shown paragraph 129: sharing a common set of interests and that agreeing upon a common set of rules to publish,

- share and access any computer content (code, data, applications, or other collections of computer representable resources); (paragraph 481) membership screening; and (paragraph 510) filtering and distributing requests for the best usage of network resources.
- e. Applicant has argued (last paragraph on page 12 to 1<sup>st</sup> paragraph on page 13 of current amendment) that Neither Arora, nor Chandra disclose or suggest retrieving a portion of stored fact information, and storing the retrieved fact information in a particular XML file using an XSL transaction; and neither Arora, nor Chandra discloses a step of combining previously retrieved fact information with an existing XML electronic document, i.e. the limitation of “wherein the electronic file is an XML document and the retrieved portion is stored in the XML document using an XSL transaction” in claim 4. Arora has shown (paragraph 662) using XML to send message of different types; (paragraph 347) XML allows advertisement translated into other encodings such as HTML and WML. Arora does not show explicitly the limitation of “wherein the electronic file is an XML document and the retrieved portion is stored in the XML document using an XSL transaction”. Chandra has shown (Fig. 18E and column 71, line 38-column 72, lines 8) that XSL style sheet is used to generate XML. Together Arora, nor Chandr have shown the argued limitation as above.
- f. Applicant argues (2<sup>nd</sup> paragraph on page 13 of current amendment) that neither Arora, nor Chandra discloses the limitation of “wherein the retrieved portion of the stored fact information pertains to at least one category selected from the group consisting

of: a business context of the incoming electronic message, analytical data relating to the incoming electronic message, availability of a person for attending to the incoming electronic message, a skill of a person for attending to the incoming electronic message, communication information relating to the incoming electronic message, an industry with which the incoming electronic message is associated, and combinations thereof" in claim 10. Examiner has searched and found that Chandra has shown (Fig. 13A and 13D; column 54, line 44-column 55, line 4) invitation to meet; (column 55, lines 57-67) schedule for availability; Arora has shown (paragraph 485) embodiments of a peer-to-peer platform discovery service may leverage surrounding peers and peer groups, provide meetings points for far away peers and groups, use an asynchronous protocol and provide reverse discovery; and (paragraph 508) a rendezvous peer may be described as a meeting point where peers and/or peer groups may register to be discovered, and may also discover other peers and/or peer groups, and retrieve information on discovered peers and/or peer groups.

*Conclusion*

9. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to the enclosed PTO-892 for details.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peling A. Shaw whose telephone number is (571) 272-7968. The examiner can normally be reached on M-F 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William C. Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished



applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Peling A Shaw/  
Examiner, Art Unit 2444